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AUG 17 2005

ANN M. CAVIANI PEASE  
1117 CALIFORNIA AVENUE  
PALO ALTO, CA 94304-1106

In re application of	:
John J. Harrington et al	:
Serial No.: 09/586,744	: PETITION DECISION
Filed: June 2, 2000	:
Attorney Docket No.: 375461-043R1	:

This is in reply to the second renewed petition filed May 31, 2005, requesting review of the second petition decision mailed March 30, 2005, denying applicants' request to have a protest expunged from the file.

#### BACKGROUND

This application, which is a reissue application for Patent No., 5,874,283, issued February 23, 1999, was filed on June 2, 2000. By Preliminary amendment Figures 8-18 were added to the application along with the required description and claims 7-73. A new CRF containing added sequences was also submitted. Notice of the filing of the reissue was published in the OG on August 22, 2000. A third party protest was filed on January 3, 2001, and considered by the examiner in preparing the first Office action mailed March 6, 2001, as well as applicants' reply thereto, filed February 14, 2001. The examiner objected to the added drawings and descriptive matter added by preliminary amendment as new matter and rejected claims 7-73 as being based on the new matter. The added claims were also rejected under 35 U.S.C. 112, first paragraph, as being based on new matter and as lacking written description in the original patent disclosure and under 35 U.S.C. 251 as not being for the same general invention as the original patent claims. Claims 51-58 were rejected under 35 U.S.C. 101 and 35 U.S.C. 112, first paragraph, as lacking utility. Claims 7-73 were further rejected under 35 U.S.C. 112, first paragraph, as lacking enablement. Claims 1 and 4-5 were rejected under 35 U.S.C. 102(a) as anticipated by Murray et al. Claims 7-9 and 51 were rejected under 35 U.S.C. 102(b) as anticipated by Lyamichev et al. Claims 7-73 were rejected under 35 U.S.C. 103(a) as unpatentable over Harrington et al. Claims 2-3 and 6 were indicated allowable. A new CRF was also required.

Applicants replied to the Office action on July 5, 2001, accompanied by a one month extension of time and fee therefor. Applicants provided a substitute sequence listing in paper and CRF form, amended the specification again and amended claims 7-9, 14, 51 and 59 and addressed all aspects of the Office action. However, the sequence CRF was defective and a new CRF

required. Due to events outside the control of the Office several unacceptable (unreadable due to X-ray scanning of mail) CRF disks were submitted prior to the submission of an acceptable CRF on May 30, 2002. During the delay in providing an acceptable CRF the third party Protester submitted a second protest addressing new issues on January 9, 2002, which was entered in the file. A reply to the protest was filed on May 30, 2002. The examiner considered the protest and reply and mailed a Final Office action to applicants on July 11, 2002. The examiner again rejected claims 7-73 under 35 U.S.C. 251 as based on new matter. Claims 7-10, 14-27, 31-44 and 48-70 were rejected under 35 U.S.C. 112, first paragraph, as lacking written description. Claims 7-73 were rejected under 35 U.S.C. 112, first paragraph, as lacking enablement, and claim 7 was rejected under 35 U.S.C. 112, second paragraph, as incomplete. Claims 7-73 were again rejected under 35 U.S.C. 103(a) as unpatentable over Harrington et al. Claim 1-6 were indicated allowable. The action was made Final.

Six months later, on January 13, 2003 (Monday), applicants filed a Notice of Appeal and request for a three month extension of time and all appropriate fees. On March 11, 2003, applicants filed a reply to the Office action of July 11, 2002, amending claims 7, 21, 36, 51 and 59 and responding to all of the rejections appropriately. The examiner replied with an Advisory action on April 1, 2003, indicating the amendments would be entered, but that they did not place the application in condition for allowance and provided comments reiterating the rejections for new matter, written description, enablement and obviousness.

Applicants filed RCE papers on August 13, 2003, accompanied by an amendment in which claims 7-20 and 36-50 were canceled and claims 21, 23-24, 26-33, 53-54, 56-59, 62-64, 66-67 and 69-73 were amended and arguments addressing all rejections were again presented.

The examiner mailed a non-Final Office action to applicants on November 18, 2003. Claims 21-35 and 51-73 were rejected under 35 U.S.C. 251 as containing new matter. Claims 21-25, 31-35 and 51-68 were rejected under 35 U.S.C. 112, first paragraph, as lacking written description. All claims were rejected on the basis of a defective reissue declaration.

Applicants replied on January 26, 2004, amending further claims 21, 23-24, 26-33, 53-54, 56-59, 62-64, 66-67 and 69-73, but did not address any of the rejections of record. A further reply was filed May 20, 2004, further amending claims 21, 31, 33, 56, 58, 62 and 64, and adding new claims 74-76. An interview summary was submitted and the rejections of record addressed.

On August 13, 2004, third party submitted a third protest which was entered in the file.

On September 2, 2004, the examiner mailed a Final Office action to applicants indicating consideration of the protest. The examiner again rejected all claims over a defective reissue declaration. The examiner rejected claims 21-35 and 51-76 under 35 U.S.C. 251 as based on new matter improperly added to the patent. The examiner rejected claims 21-25, 31-35, 51-68 and 74-76 under 35 U.S.C. 112, first paragraph, as lacking written description. The examiner made the action Final. A Notice of Appeal was filed on March 3, 2005.

Applicants submitted a first petition to expunge the last third party protest on October 6, 2004 as being in violation of the Rules of Practice. The petition was denied on January 13, 2005. A

renewed petition was filed on March 14, 2005 and was denied by decision mailed March 30, 2005. Applicants have now filed a third petition again requesting the protest be expunged and the director's previous decision be reversed.

## DISCUSSION

Applicants' petition requests that the last protest be expunged as it violates Office policy as to the limited extent that third party Protesters may have in prosecution of reissue applications and that it does not raise or address any new issues not previously before the Office. Thus a review of the three protests filed is in order.

**PROTEST I – Issue 1** – Protester alleges no proper error is identified for which reissue is appropriate; specifically applicants are trying to claim non-elected subject matter canceled without traverse in response to a restriction requirement..

Issue 2 – Added claims are not directed to the same general invention as claimed in the patent and the reissue is therefore improper.

Issue 3 – Added claims are broader than the original claims and attempt to recapture subject matter surrendered during prosecution of the original patent application.

Issue 4 – Added claims are unsupported by the original disclosure and applicants are attempting to improperly incorporate contents of a non-patent document into the specification for support.

The above issues were addressed in a reply to the protest by applicants, as follows:

Issue 1 – Applicants state that the error upon which reissue is based is that they claimed less than they had a right to claim and arose without deceptive intention. Specifically, applicants now claim inventions disclosed, but not claimed in the original application, i.e. – methods of cleavage of certain structures, hybridization techniques and kits comprising FEN-1 polypeptides, none of which were claimed in the original application and are thus proper for reissue.

Issue 2 – Applicants added claims are for an invention disclosed in the original application and are therefore related to the originally patented invention and are therefore to the same general invention.

Issue 3 – Reissue applications filed within two years of the issue date of the patent may be broadened. The application was filed within the two year time period.

Issue 4 – Applicants are not attempting to recapture subject matter surrendered during the prosecution of the patent in order to gain allowance of the original claims. The subject matter now claimed was not claimed in the original application and therefore not surrendered.

The examiner adopted, at least in part, Protester's new matter and recapture issues as evidenced by the rejections under 35 U.S.C. 112, first paragraph, for new matter and lack of written description and under 35 U.S.C. 251, for new matter and improper recapture.

**PROTEST II – Issue 1** – Applicants' incorporation by reference is improper with respect to double flap structures and discusses proper and improper incorporation by reference.

Issue 2 – Applicants attempt to redefine double-flap structures in a manner which is inconsistent with the definition in the original patent specification.

Applicants replied by contending that the second protest was improper, but also addressed the issues presented, as follows:

Issue 1 – Applicants point out where specific incorporation by reference is made in the original specification which clearly identifies the material to be incorporated by reference.

Issue 2 – Applicants dispute Protester's allegation that they are attempting to redefine double-flap structures and point to specific areas of the specification and material incorporated by reference showing support for the structures as now claimed.

The examiner again considered the protest, but did not specifically adopt protester's positions except as to support the rejections already of record in making the Office action Final.

PROTEST III – Issue 1 – Applicants have mischaracterized the identification of FEN-1 endonucleases to overcome written description problems.

Issue 2 – Applicants admit that the inventions now claimed are different from that claimed in the original application.

Issue 3 – Applicants misstate the law in attempting to incorporate double-flap concepts into the application.

Issue 4 – Applicants mischaracterize the specification in attempting to incorporate the double-flap concept into the specification.

Issue 5 – Applicants' amendments are insufficient to overcome the written description problems of the unamended independent claims.

The examiner considered the third protest, but appears not to have adopted any of the arguments or positions presented by protester.

As noted above, the issues raised by protester in the first protest were, at least in part, adopted by the examiner in the first Office action. The examiner specifically did not adopt protester's position that the added claims were to a different invention and thus improper as more recent court decision than those cited by protester have permitted this, although the examiner could have required restriction between the newly added inventions and those originally patented, but did not. Whether in a single reissue application or multiple divisional reissue application, the newly added claims would, of necessity, have been considered. Applicants' admissions that the new claims are to a different statutory class of invention is not indicative that the claims are not to the same general invention as originally claimed. Such was recognized by the examiner and that part of the protest not adopted. The same applied to the question of improper broadening which was not adopted.

Protester's second protest, also considered by the examiner, was, in general, not adopted as the issues had already been raised by the examiner in the previous Office action. However, protester's comments on applicants' responses to the issues presented alternative views not necessarily considered by the examiner. It is noted that the guidelines on incorporation by reference have been significantly relaxed since the court decisions cited by protester. The question of written description of double-flap structures in the original disclosure is paramount to determination of whether claims meet the written description requirement and are allowable and is directly related to proper incorporation by reference. While the second protest could have been denied entry, the value of the arguments relating to the new issues raised by protester,

especially the question of support for double-flap structures, was considered more important to the prosecution than denial of entry of the protest would have been.

Protester's third protest was considered by the examiner prior to applicants' petition to expunge the protest was filed. Although protester states that the issues presented are new, upon further review they are considered to be reiteration of narrowed aspects of the original and/or second protests. It is noted that the examiner considered the protest, but did not adopt any of the issues presented therein as they had previously been addressed and resolved. Thus the protest is essentially moot. In retrospect the entry of the protest is questionable, but was made based upon Protester's statements that the issues presented were new and could not have been raised before due to applicants' conduct of the prosecution. However, as the examiner has considered the protest, as stated in the last Office action, it would be improper at this point in time to expunge the protest as it would create an incomplete record.

Applicants' petition is again **DENIED**.

In view of applicants' filing of a Notice of Appeal, applicants remain under obligation to file an Appeal Brief within the time period set in 37 CFR 1.192, or as may be extended under 37 CFR 1.136(a).

Should there be any questions about this decision please contact William R. Dixon, Jr., by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0519 or by facsimile sent to the general Office facsimile number, 571-273-8300.



Bruce M. Kisliuk  
Director, Technology Center 1600